137-41

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1890.

No. 1213.

THE DABLE GRAIN SHOVEL COMPANY, PLAINTIFF IN ERROR,

vs.

EDWARD E. FLINT AND JAMES W. ODELL, COPARTNERS AS FLINT, ODELL & COMPANY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF ILLINOIS.

FILED JULY 12, 1890.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1890.

No. 1213.

THE DABLE GRAIN SHOVEL COMPANY, PLAINTIFF IN ERROR,

vs.

EDWARD E. FLINT AND JAMES W. ODELL, COPARTNERS AS FLINT, ODELL & COMPANY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF ILLINOIS.

INDEX.

	Original.	Print.
Caption	1	1
Præcipe for summons	2	1
Bond for costs	3	2
Declaration	4	2
Summons	9	4
Marshal's return	10	5
Pleas	11	5
Replication	19	9
Demurrer to replication	25	11
Joinder in demurrer	27	12
Stipulation waiving jury, &c.	28	12
Order taking cause under advisement	30	13
Opinion	31	13
Judgment	35	15
Bond	37	16
Clerk's certificate	39	16
Writ of error	40	17
Citation and proof of service of same	41	17
Assignment of errors	42	18

JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C., JULY 17, 1890.

1 Pleas in the circuit court of the United States of America for the northern district of Illinois, held at the United States court-rooms, in the city of Chicago, in the district aforesaid, before the Hon. Henry W. Blodgett, judge of the district court of the United States for the northern district of Illinois, on Monday, the thirty-first day of March, in the adjourned March term of said court, in the year of our Lord one thousand eight hundred and ninety, and of our Independence the one hundred and fourteenth year.

WM. H. BRADLEY, *Clerk.*

THE DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT AND JAMES W. ODELL, Composing the Firm of Flint, Odell & Co. } Trespass on the Case.

NORTHERN DISTRICT OF ILLINOIS, *ss:*

Be it remembered that on the twenty-sixth day of July, 1889, came the plaintiff, by its attorney, and filed in the clerk's office of the circuit court of the United States for the northern district of Illinois, at Chicago, in said district, its præcipe for a writ of summons, and also at the same time filed its bond for costs in said entitled
2 cause; which said præcipe and bond are in the words and figures following, to wit:

Præcipe.

United States Circuit Court, Northern District of Illinois.

THE DABLE GRAIN SHOVEL COMPANY, Plaintiff,
vs.
FLINT, ODELL AND CO., Defendant.

The clerk of the said court will issue a summons in the above-entitled case in a plea of trespass on the case, in damages of one hundred thousand dollars, and direct the same to the marshal to execute and make it returnable to October term of said court, A. D. 1889.

WM. ZIMMERMAN,
Plaintiff's Attorney.

July 26th, 1889.

(Endorsed:) Filed July 26, 1889. Wm. H. Bradley, clerk.

3 *Bond for Costs.*

UNITED STATES OF AMERICA,
Northern District of Illinois, Northern Division, } *ss:*

Circuit Court. October Term, A. D. 1889.

THE DABLE GRAIN SHOVEL COMPANY
vs.
FLINT, ODELL AND CO. } In Case.

I enter myself security for costs in this cause and promise to pay all costs which may accrue to the opposite party in this action or to any of the officers of this court, and in default of payment by the plaintiff of any costs ordered or adjudged to be paid by it I hereby agree and stipulate that execution may issue against my property for any costs taxed against it.

Dated this 26th day of July, A. D. 1889.

WM. ZIMMERMAN.

(Endorsed:) Filed July 26, A. D. 1889. Wm. H. Bradley, clerk.

4 On the same day, to wit, on the twenty-sixth day of July, 1889, came the plaintiff, by its attorney, and filed in said clerk's office its declaration in said entitled cause; which said declaration is in the words and figures following, to wit:

Declaration.

Circuit Court of the United States for the Northern District of Illinois. October Term, A. D. (1889) eighteen hundred and eighty-nine.

NORTHERN DISTRICT OF ILLINOIS, *ss:*

The Dable Grain Shovel Co., plaintiff, a corporation duly organized and existing in due form under and by virtue of the laws of the State of Illinois and having its principal office in the city of Chicago, brings this suit by Wm. Zimmerman, its attorney, against the firm of Flint, Odell & Co., of Chicago, Illinois, defendants, of a plea of trespass on the case:

For that whereas John Dable, of Chicago, Illinois, before and at the time of his application for the hereinafter-mentioned letters patents, was a citizen of the United States and was the true, original, sole, and first inventor of certain new and useful machines, fully described and claimed in the specifications of the letters patents hereinafter mentioned, and named in them each respectively an "improvement in machines for unloading railroad cars,"

5 which were not known or used in this country and not patented nor described in any printed publication in this or any foreign country before his invention thereof, and were not in public use or on sale for more than two years prior to his applica-

tion for letters patents of the United States for them each respectively.

And for that whereas letters patent for one of the said inventions, in due form of law, were, on the application of the said John Dable, issued and delivered to him in the name of the United States of America and under the seal of the Patent Office of the United States, and were signed by the acting Secretary of the Interior and countersigned by the Commissioner of Patents, granting to the said John Dable, his heirs, administrators, or assigns, for the term of seventeen (17) years from the seventh (7) day of August, A. D. eighteen hundred and sixty-six (1866), the sole and exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof.

And for that whereas letters patent for another of said inventions, in due form of law, were, on the application of the said John Dable, issued and delivered to him in the name of the United States of America and under the seal of the Patent Office of the United States, and were signed by the acting Secretary of the Interior and countersigned by the acting Commissioner of Patents, granting to
6 the said John Dable, his executors, administrators, or assigns, for the term of seventeen (17) years from the twenty-eighth (28) day of July, eighteen hundred and sixty-eight (1868), the exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof.

And for that whereas the plaintiff further says that the said inventions and machines so patented as aforesaid to the said inventor were and are capable of conjoint use each with the other in their several parts as one operative and entire machine.

And for that whereas heretofore, to wit, on the eighth (8) day of December, A. D. eighteen hundred and eighty (1880), the said John Dable, by an instrument in writing duly executed and delivered by him, and bearing date on last-named day, did assign and transfer to the said Dable Grain Shovel Co., of Chicago, Ill., all his rights, titles, and interests in and to said letters patents, and also all rights of action whatever accrued thereunder before the date of said assignment in said inventions, as by reference unto said instrument being had will more fully and at large appear.

And the plaintiff further says that said instrument in writing was duly recorded in the Patent Office of the United States.

And which the said letters patents, together with the said instrument of assignment or duly certified copies of the same, the plaintiff now brings into court.

7 And the plaintiff further says that the said letters patents have by this court, before the Honorable Henry W. Blodgett, in the year A. D. eighteen hundred and seventy-three, in the December term, on the chancery side thereof, wherein the said John Dable was plaintiff and George Armour *et al.* defendants, been adjudged and decreed valid, as by reference to the record on file in this court will more fully and at large appear; yet the defendants, well knowing the premises, but having contrived and wrongfully and injuriously intended to injure the rightful owners of their rights secured

unto them by their said letters patents, and to deprive them of the profits, benefits, and advantages which they might and otherwise would have derived and acquired from making, using, exercising, and vending of the said inventions, after the issue of the said letters patents and before the bringing of this suit, and within the said term of years in the said letters patents mentioned as aforesaid, unlawfully and unjustly, without leave or license and against the will of the plaintiffs, made and used divers devices, to wit, about seventeen (17) each of said machines, in grain elevators in the city of Chicago, which are known as the "Rock Island Elevators" "A" and "B," respectively, in imitation of the said inventions patented to the said John Dable as aforesaid, and thereby hindered and pre-
8 vented the rightful owners, as above shown, in the sole use, exercise, and enjoyment of the same, whereby, by reason of such infringement, they have sustained actual damages to the amount of one hundred thousand dollars ($100,000). Wherefore, by force of the statutes of the United States, a right of action has accrued to the said plaintiff to recover the said actual damages and such additional amount, not exceeding in the whole three times the amount of such actual damages as the court may see fit to adjudge and order, together with the costs of this suit.

Yet the defendant, though often requested so to do, has never paid the same nor any part thereof, but has refused and still refuses so to do, to the injury of the said complainant; and therefore the plaintiff brings this suit.

WM. ZIMMERMAN,
Attorney for Plaintiff.

(Endorsed:) Filed July 26, 1889. Wm. H. Bradley, clerk.

9 On the same day, to wit, on the twenty-sixth day of July, 1889, there issued out of said clerk's office a writ of summons in said entitled cause; which said writ, together with the return of the marshal endorsed thereon, is in the words and figures following, to wit:

Summons.

CIRCUIT COURT OF THE UNITED STATES OF AMERICA, *Northern District of Illinois*, } ss:

The United States of America to the marshal of the northern district of Illinois, Greeting:

We command you to summon Flint, Odell & Co., if found in your district, to be and appear before our judges of our circuit court of the United States for the northern district of Illinois on the first day of the next term thereof, to be holden at Chicago, in the district aforesaid, on the first Monday of October next, to answer unto Dable Grain Shovel Company, a corporation, &c., of a plea of trespass on the case, to its damage, as is alleged, of one hundred thousand dollars; and have you then and there this writ.

[SEAL.] Witness the Hon. Melville W. Fuller, Chief Justice of the Supreme Court of the United States of America, at Chicago aforesaid, this 26th day of July, in the year of our Lord one thousand eight hundred and 89, and of our Independence the 114th year.

10

WM. H. BRADLEY, *Clerk.*

Marshal's Return.

I have served the within writ by reading the same to and within the presence and hearing of James W. Odell on the 26th day of August, A. D. 1889, and Edward E. Flint, therein named, on the 28th day of August, 1889.

F. H. MARSH,
U. S. Marshal,
By GEO. N. JONES, *Deputy.*

(Endorsed:) Filed Aug. 28, A. D. 1889. Wm. H. Bradley, clerk.

Afterward, to wit, on the fifth day of October, 1889, came the defendants, by their attorneys, and filed in said clerk's office their pleas in said entitled cause; which said pleas are in the words and figures following, to wit:

11

Pleas.

Circuit Court of the United States, Northern District of Illinois.

THE DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT AND JAMES W. ODELL, Copartners by the Firm Name of Flint, Odell & Co. } Case.

First plea. And now come the defendants, by Banning & Banning & Payson, their attorneys, and defend the wrong and injury, when, etc., and say that they are not guilty of the said supposed grievances above laid to their charge, or any or either of them, in manner and form as the plaintiff has above declared against them, and of this the defendants put themselves upon the country.

Second plea. And for a further plea in this behalf the defendants say that the plaintiff ought not to have or maintain its aforesaid action against them as to the several supposed causes of action in said declaration mentioned which accrued prior to July 26, 1884, because they say that said several supposed causes of action did not, nor did any or either of them, accrue to the plaintiff at any time within five years next before the commencement of this suit,

12 in manner and form as the plaintiff has above complained against them, and this the defendants are ready to verify; wherefore they pray judgment if the plaintiff ought to have or maintain its aforesaid action against them as to said several supposed causes of action.

Third plea. And for a further plea in this behalf the defendants say that the plaintiff ought not to have or maintain its aforesaid

action against them as to the several supposed causes of action in said declaration mentioned which accrued prior to December 8, 1880, because they say that the said John Dable did not and could not assign or transfer said several supposed causes of action to the plaintiff in such a way as to enable it to maintain an action at law to recover the same in its own name, and this the defendants are ready to verify; wherefore they pray judgment if the plaintiff ought to have or maintain its aforesaid action against them as to said several supposed causes of action.

Fourth plea. And for a further plea in this behalf the defendants say that the plaintiff ought not to have or maintain its aforesaid action against them, because they say that the only machines for unloading grain from railroad cars ever used by them during the life of either of said patents set forth in said declaration were
13 constructed and put into use in their grain elevators by the said John Dable, and with his consent and allowance, while he was in their employ as superintendent of machinery, and prior to his application for either of said letters patent, and thereby and by virtue of the statute in such case made and provided the defendants became possessed of the right to use all said machines during the life of each of said patents without liability to the said John Dable or the plaintiff, and this the defendants are ready to verify; wherefore they pray judgment if the plaintiff ought to have or maintain its aforesaid action against them.

Fifth plea. And for a further plea in this behalf the defendants say that the plaintiff ought not to have or maintain its aforesaid action against them, because they say that the only machines for unloading grain from railroad cars ever used by them during the life of either of said patents set forth in said declaration were constructed and put into use in their grain elevators by the said John Dable, and with his consent and allowance, while he was in their employ as superintendent of machinery, and that all said Dable's work in experimenting on or in making and perfecting said pretended inventions was conducted while he was in their employ, in the line of his employment, during the time for which he was paid by them, with their tools and machinery and wholly at their
14 expense, and the defendants thereby became possessed of the right to use said machines during the life of each of said patents, in which right the said John Dable and the plaintiff afterwar ls acquiesced for the period of about twenty-four years, and this the defendants are ready to verify; wherefore they pray judgment if the plaintiff ought to have or maintain its aforesaid action against them.

Sixth plea. And for a further plea in this behalf the defendants say that the plaintiff ought not to have or maintain its aforesaid action against them, because they say that in view of the mechanic arts, as the same were well known at the date of said alleged inventions, only mechanical skill, as distinguished from the exercise of the inventive faculty, was required in making the pretended improvements described and claimed in each of said letters patent, and this the defendants are ready to verify; wherefore they pray judg-

ment if the plaintiff ought to have or maintain its aforesaid action against them.

Seventh plea. And for a further plea in this behalf the defendants say that the plaintiff ought not to have or maintain its aforesaid action against them, because they say that neither of said patents set forth in said declaration disclosed, described, or claimed a patentable combination, within the meaning of the law, but that
15 the subject-matter thereof and of each of them was a mere aggregation of old parts which continued to perform substantially the same functions in substantially the same way as before, without modifying the action of each other or being affected by their relation to each other, and this the defendants are ready to verify; wherefore they pray judgment if the plaintiff ought to have or maintain its aforesaid action against them.

Eighth plea. And for a further plea in this behalf the defendants say that the plaintiff ought not to have or maintain its aforesaid action against them, because they say that the said John Dable was not the original and first inventor of the pretended inventions and improvements described and claimed in said letters patent set forth in said declaration or either of them, but that said pretended inventions or improvements or substantial and material parts thereof were shown and described in the following patents and printed publications prior to his pretended invention thereof, to wit:

United States Patents.

No. 1228, issued to A. Hathaway, July 9, 1839.
" 5346, " " E. S. Townsend, October 30, 1847.
" 11342, " " P. B. Tyler, July 18, 1854.
" 12275, " " H. A. Frost, January 23, 1855.
" 12524, " " F. W. Urann, March 13, 1855.
" 15557, " " C. S. Bruff, August 19, 1856.
" 18734, " " A. C. Frederick, December 1, 1857.
" 21238, " " N. Adams, August 24, 1858.
16 No. 1922 (reissue), issued to P. E. Palmer, April 11, 1865.
" 26261, " " H. Ehrenfeld, November 29, 1859.
No. 27410, issued to Kelty & Harold, March 6, 1860.
" 31505, " " C. Wilson, February 19, 1861.
" 1617 (reissue), issued to D. M. Cochran, February 16, 1864.
" 38913, " " W. F. Redding, June 16, 1863.
" 40466, " " A. C. Flint, November 3, 1863.
" 44151, " " Ballard & Sargent, September 13, 1864.
No. 43751, " " Wilson, Spendelow & Watson, Aug. 2, '64.
No. 44937, " " E. M. Clark, November 8, 1864.
" 46785, " " B. F. Dunning, March 14, 1865.
" 57302, " " J. Edson, August 21, 1866.
" 17085, " " G. Gilmour, April 21, 1857.
" 1853 (reissue), " " G. Focht, January 17, 1865.

No. 32856, issued to L. A. Beardsley, July 23, 1861.
" 43541, " " Whitcomb & Paddock, July 12, 1864.
" 79653, " " J. E. Gustin, July 7, 1868.

Printed Publications.

Threatrum Machinarum, by Jacob Leopold. Leipsic, A. D. 1724. In volume 2, pages 98, '9, plate 18, and in volume 3, page 61, plate 26.

The Principles of Mechanics, by W. Emerson. London, 1773. Page 211, plate 233, and page 241, figure 283.

The Repertory of Arts and Manufactures, etc. London. Volume 10 of 1799, pages 273, '4.

And this the defendants are ready to verify; wherefore they pray judgment if the plaintiff ought to have or maintain its aforesaid action against them.

Ninth plea. And for a further plea in this behalf the de-
17 fendants say that the plaintiff ought not to have or maintain its aforesaid action against them so far as regards said patent No. 80276, because they say that the said John Dable had previously taken out a patent, to wit, patent No. 56906, in which he showed and described, but did not claim, substantially the same subject-matter, and that by reason thereof he abandoned and dedicated said subject-matter to the public, and this the defendants are ready to verify; wherefore they pray judgment if the plaintiff ought to have or maintain its aforesaid action against them.

Tenth plea. And for a further plea in this behalf the defendants say that the plaintiff ought not to have or maintain its aforesaid action against them on account of the decision in said declaration alleged to have been obtained in a suit against George Armour and others, because they say that they were not directly or indirectly parties to said suit or — any way connected therewith, and that said decision was obtained by consent or on a record containing only a partial and insufficient presentation of the prior art and of facts connected therewith and with the making of said pretended inventions, and that the defendants are in no way bound or ought to be prejudiced thereby, and this the defendants are ready to verify; where-
fore they pray judgment if the plaintiff ought to have or
18 maintain its aforesaid action against them.

BANNING & BANNING & PAYSON,
Attorneys for Defendants.

(Endorsed:) Filed Oct. 5, 1889. Wm. H. Bradley, clerk.

19 Afterward, to wit, on the thirtieth day of November, 1889 came the plaintiff, by its attorney, and filed in said clerk's office its replication to the pleas in said entitled cause; which said replication is in the words and figures following, to wit:

Replication.

Circuit Court of the United States, Northern District of Illinois.

THE DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT and JAMES W. ODELL, Co-partners by the Firm Name of Flint, Odell & Co. } Trespass on the Case.

1st. The plaintiff, as to the said plea of the defendants by them first above pleaded and whereof they put themselves upon the country, doth the like.

2nd. And the said plaintiff, as to the plea of the said defendants by them secondly above pleaded, says that the said plaintiff, by reason of anything by the said defendants in that plea alleged, ought not to be barred from having and maintaining its aforesaid action against the said defendants, because it says that the said several causes of action in the said declaration mentioned and each and every of them did accrue to the said plaintiff within six
20 years next before the commencement of this suit in manner and form as it, the said plaintiff, has above complained against the said defendants; and this the said plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and its damages by it sustained by reason of the said several grievances, to be adjudged to it.

3rd. And the said plaintiff, as to the plea of the said defendants by them thirdly above pleaded, says that the said plaintiff, by reason of anything by the said defendants in that plea alleged, *it* ought not to be barred from having and maintaining its aforesaid action against the said defendants, because it says that the said John Dable assigned and transferred his rights under said patents in manner and form as provided by law; and this the said plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and its damages by it sustained by reason of the said several grievances, to be adjudged to it.

4th. And the said plaintiff, as to the plea of the defendants by them fourthly above pleaded as to the said several trespasses in said plea attempted to be justified, says that the plaintiff, by reason of anything in said plea alleged, ought not to be barred from having and maintaining its action, because it says that the said defendants did not, by statute in such case made and provided, become
21 possessed of the right to use all the said machines made according to John Dable's invention of the said machines in manner and form as by the defendants alleged; and this the plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and its damages by it sustained by reason of the said several grievances, to be adjudged to it.

5th. And the said plaintiff, as to the plea of the defendants by them fifthly above pleaded as to the said several trespasses in said plea attempted to be justified, says that the said plaintiff, by reason of

anything by the said defendants in that plea alleged, ought not to be barred from having and maintaining its action, because it says that the said John Dable made only one machine for unloading grain from railroad cars of either kind mentioned in the declaration which could be called an experimental machine, made at the expense of his employers or with their machinery and at their expense, &c.; and as to the remaining number of machines, he neither licensed nor acquiesced in the trespass of the defendants at any time; and this the plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and its damages by it sustained by reason of the committing of the said several grievances, to be adjudged to it.

22 6th. And the plaintiff, as to the plea of the defendants by them sixthly above pleaded, says that the inventions and improvements in machines for unloading grain from railroad cars such as described and claimed in each of the letters patent to John Dable mentioned in the declaration of the said plaintiff were produced by the exercise of the inventive faculty; and this the said plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and the damages by it sustained by reason of the committing of the said grievances, to be adjudged to it.

7th. And the plaintiff, as to the plea of the defendants by them seventhly above pleaded, says that the subject-matter in each of said letters patent set forth in said declaration disclosed patentable combinations not before known or used in the arts to which the inventions described and claimed in the said letters patent relate; and this the plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and the damages by it sustained by reason of the committing of the said several grievances, to be adjudged to it.

8th. And the plaintiff, as to the plea of the defendants by them eighthly above pleaded, says that the substantial and material parts of the inventions set out in the said letters patent to the said John Dable and mentioned by the plaintiff in its declarations were

23 not anticipated in the United States letters patent for inventions nor in the printed publications, or either of them, which are set out and enumerated by number, title, &c., in the said eighth plea of the said defendants, but that the said John Dable was the original and first and sole inventor of the improvement described and claimed in his said several letters patent mentioned in the above declaration; and this the said plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and its damages by it sustained by reason of the said several grievances, to be adjudged to it.

9th. And the plaintiff, as to the plea of the defendants by them ninethly above pleaded, says that the said John Dable did not show and describe in his previous patent, to wit, number fifty-six thousand nine hundred and six (56,906), the inventions shown and described in his subsequent patent, to wit, number eighty thousand two hundred and seventy-six (80,276), and abandon and dedicate the subject-matter of said last patent to the public, as in the said ninth plea al-

leged; and this the said plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and the damages by it sustained by reason of the committing of the said several grievances, to be adjudged to it.

10th. And the said plaintiff, as to the plea of the defend-
24 ants by them tenthly above pleaded as to the said several trespasses in said plea attempted to be justified, says that the plaintiff, by reason of anything in said plea alleged, ought not to be barred from having and maintaining its action, because it says that the said defendants now before this court were part and parcel of a party, company, or combination who contested against the legal course through which the decision against the parties alleged in the declaration was obtained in favor of John Dable on a full and lawfully contested record; and this the said plaintiff prays may be inquired of by the country.

Wherefore it prays judgment and its damages by it sustained by reason of the committing of the said trespasses, to be adjudged to it.

WM. ZIMMERMAN,
Attorney for Plaintiff.

(Endorsed:) Filed Nov. 30, 1889. Wm. H. Bradley, clerk.

25 Afterward, to wit, on the twenty-eighth day of December, 1889, came the defendants, by their attorneys, and filed in said clerk's office their demurrer to the replication in said entitled cause; which said demurrer is in the words and figures following, to wit:

Demurrer.

Circuit Court of the United States, Northern District of Illinois.

THE DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT and JAMES W. ODELL, Copartners by the Firm Name of Flint, Odell & Co. } Case.

The defendants, by Banning & Banning & Payson, their attorneys, come and defend, etc., when, etc., and say that the said replication of the plaintiff to the second plea of the defendants and the matters therein contained in manner and form as the same are above set forth are not sufficient in law for the plaintiff to maintain his aforesaid action, and that they, the defendants, are not bound by law to answer the same, and this they are ready to verify; wherefore, for want of a sufficient replication in this behalf, the defendants pray judgment, and that the plaintiff may be barred from maintaining his aforesaid action, etc.

26 2nd. The defendants say that the said replication of the plaintiff to the third plea of the defendants and the matters therein contained in manner and form as the same are above set forth are not sufficient in law for the plaintiff to maintain his aforesaid action, and that they, the defendants, are not bound by law to

answer the same, and this they are ready to verify; wherefore, for want of a sufficient replication in this behalf, the defendants pray judgment, and that the plaintiff may be barred from maintaining his aforesaid action.

3rd. And the defendants, as to the said replications of the plaintiff to the fourth, fifth, sixth, seventh, eighth, ninth, and tenth pleas of the defendants, and which the plaintiff has prayed may be inquired of by the country, do the like.

BANNING & BANNING & PAYSON,
Attorneys for Defendants.

(Endorsed:) Filed Dec. 28, 1889. Wm. H. Bradley, clerk.

27 Afterward, to wit, on the fifteenth day of January, 1890, came the plaintiff, by its attorney, and filed in said clerk's office its joinder in demurrer in said entitled cause; which said joinder is in the words and figures following, to wit:

Joinder in Demurrer.

Circuit Court of the United States, Northern District of Illinois.

THE DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT and JAMES W. ODELL, Co-partners by the Firm Name of Flint, Odell & Co. } Trespass on the Case.

And the plaintiff says that the said second and third counts of the replication and the matters therein contained in manner and form as the same are above set forth are sufficient in law to have and maintain its action, and this it is ready to verify. Wherefore, inasmuch as the defendants have not answered the said second and third counts of the replication nor hitherto in any manner denied the same, the plaintiff prays judgment and its damages by it sustained by reason of the aforesaid trespass, to be adjudged to it, etc.

(Endorsed:) Filed Jan'y 15, 1890. Wm. H. Bradley, clerk. Wm. Zimmerman, plaintiff's attorney.

28 Afterward, to wit, on the fourth day of February, 1890, there was filed in said clerk's office a stipulation in said entitled cause; which said stipulation is in the words and figures following, to wit:

Stipulation.

Circuit Court of the United States, Northern District of Illinois.

THE DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT and JAMES W. ODELL. } Case.

It is hereby stipulated by counsel that whenever the demurrers to the plaintiff's replication to the defendants' second and third

pleas are argued the above-entitled cause shall also be argued and submitted to the court, a jury being hereby waived on the following stipulation as to the defendants' fourth and fifth pleas, namely:

That the facts stated in said fourth and fifth pleas are as therein stated, except that John Dable, the patentee, claimed compensation from the defendants for the use of his invention covered by his letters patent sued on at the time he obtained said letters patent respectively, which claim the defendants refused to recognize.

29 If the court hold that the facts stated in said pleas, with the additional facts above admitted, constitute a good defense to said action, then judgment is to be entered in the defendants' favor; but if the court holds that said facts do not constitute a good defense, then the cause is to go on in the regular way, in which case this stipulation shall not prevent either party from showing any facts they may be able to prove in reference to the above matter.

Chicago, January 29th, 1890.

WM. ZIMMERMAN, *Attorney for Plaintiff.*
BANNING & BANNING & PAYSON,
Attorneys for Defendants.

(Endorsed:) Filed Feb'y 4, 1890. Wm. H. Bradley, clerk.

30 On the same day, to wit, on the fourth day of February, 1890, in the December term of said court, 1889, in the record of the proceedings thereof in said entitled cause, before Hon. Henry W. Blodgett, district judge, is the following entry, to wit:

Order.

THE DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT and JAMES W. ODELL, Composing the Firm of Flint, Odell and Company. } Case.

Now come the parties, by their attorneys, and now comes on to be heard the demurrer of the defendants to the plaintiff's replication to the second and third pleas and the stipulation as to the fourth and fifth pleas and waiving a jury, filed herein, and after hearing the arguments of the counsel the court takes the same under advisement.

31 Afterward, to wit, on the thirty-first day of March, 1890, there was filed in said clerk's office the opinion of Judge Blodgett in said entitled cause; which said opinion is in the words and figures following, to wit:

Opinion.

DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT *et al.*

BLODGETT, *J.:*

This is an action at law for the alleged infringement of a patent

issued to John Dable on the 7th day of August, 1866, for an "improvement in machines for unloading railroad cars," and a patent granted to the said John Dable on the 28th day of July, 1868, for an "improvement" upon said first-mentioned patent, which patents, it is averred, were, on the 8th day of December, 1880, duly assigned to the plaintiff, together with all claims and rights of action for past use of said patented devices, and by this action plaintiff seeks to recover damages for the use of the said patents, not only since it became the assignee thereof, but for the use of the same by defendants before such assignment.

Defendants have interposed numerous pleas in the case, but I deem it necessary to consider only the fourth, which is in sub-
32 stance that the only machines for unloading grain from railroad cars ever used by defendants during the life of either of said patents were constructed and put into use in defendants' grain elevators by the said patentee, John Dable, and with his consent and allowance while he was in their employ as superintendent of machinery and prior to his application for either of said letters patent, whereby defendants claim that they became possessed of the right to use all of said machines during the life of each of said patents without liability to the said John Dable or the plaintiff, as his assignee.

The parties have also filed a stipulation in the case admitting that the facts stated in the fourth plea are true, but with the further fact to be considered in connection with the facts stated in the plea that the patentee when he obtained the patents in question demanded compensation of the defendants for the use of his said invention. By this stipulation the question submitted to the court is whether the plea states a valid defense to the action, admitting the fact that Dable, when his patents were issued, demanded compensation from defendants for their use.

Section VII of the act of March 3, 1839, in relation to patents, vol. 5, Stats. at Large, page 354, which was in force at the time these patents were granted and has substantially been in force since that time under the various re-enactments and revisions of the patent laws, provides—

33 "That every person or corporation who has or shall have purchased or constructed any newly invented machine, manufacture, or composition of matter prior to the application by the inventor or discoverer for a patent shall be held to possess the right to use and vend to others to be used the specific machine, manufacture, or composition of matter so made or purchased without liability therefor to the inventor or any other person interested in such invention."

The allegation in this plea that the machines used by the defendants were constructed by the patentee, John Dable, while in defendants' employ and put into use in the defendants' elevators by his consent and allowance before he applied for his patents seems to me to make a complete defense under this statute, and the only additional fact brought into the case by the stipulation that when he received the patents, which must have been after they were applied for, Dable demanded compensation for the use of the patents and

the defendants refused to recognize his rights thereto, does not, in my opinion, affect the defense raised by the plea, because if Dable had no right to compensation a demand could not give him such right. By the showing of the plea there was no patent upon these machines at the time they were constructed and put into use in the defendants' elevator, and such construction and use, according to the statements of the plea, was with the consent and allowance of the patentee.

34 I do not see how a case could be made to bring the defense more clearly within the provisions of the statute than is made by this plea, and the additional fact stated in the stipulation does not change the effect of the plea.

The plea is therefore held to be a complete defense to the suit.

Banning & Banning & Payson, for defendants; William Zimmerman, for plaintiff.

(Endorsed :) Filed M'ch 31, 1890. Wm. H. Bradley, clerk.

35 On the same day, to wit, on the thirty-first day of March, in the adjourned March term of said court, 1890, in the record of the proceedings thereof in said entitled cause, before Hon. Henry W. Blodgett, district judge, is the following entry, to wit:

Judgment.

THE DABLE GRAIN SHOVEL COMPANY
vs.
EDWARD E. FLINT and JAMES W. ODELL, Composing the Firm of Flint, Odell & Co. } Trespass on the Case.

This cause having been heretofore submitted to the court on the demurrer to the plaintiff's replication to defendants' second and third pleas and on a stipulation in writing waiving a jury, and that the facts stated in defendants' fourth and fifth pleas are true, with the further fact that the patentee, John Dable, at the time he obtained the patents sued upon herein, claimed compensation from defendants for the use of his said inventions, which claim defendants refused to recognize, and the court, being now fully advised in the premises, doth sustain the demurrer to said second and third pleas, and doth further find that the facts stated in said fourth plea and said stipulation constitute a good and complete defense in law to this action.

The court therefore finds the issues of fact on the fourth
36 and fifth pleas for the defendants, and doth upon the issue on said fourth plea order and adjudge that this cause be dismissed, and that the defendants do have and recover of the plaintiff their costs herein to be taxed, and that they have execution therefor.

37 Afterward, to wit, on twenty-third day of May, 1890, there was filed in said clerk's office a bond in said entitled cause; which said bond is in the words and figures following, to wit:

Bond.

Know all men by these presents that we, The Dable Grain Shovel Company of Chicago, Illinois, are held and firmly bound unto Edward E. Flint and James W. Odell in the full and just sum of three hundred dollars, to be paid to the said Edward E. Flint and James W. Odell, certain attorney, executors, administrators, or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents.

Sealed with our seals and dated this fifth day of May, in the year of our Lord one thousand eight hundred and ninety.

Whereas lately, at a trial in the circuit court of the United States for the northern district of Illinois, in a suit depending in said court between The Dable Grain Shovel Company as plaintiff and Edward E. Flint and James W. Odell as defendants, judgment was rendered against the said plaintiff, and the said plaintiff having obtained a writ of error and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said Edward E. Flint and James W. Odell, citing and admonishing them to be and appear at
38 a Supreme Court of the United States to be holden at Washington the second Monday of October next:

Now the condition of the above obligation is such that if the said The Dable Grain Shovel Company shall prosecute its said writ of error to effect and answer all damages and costs if it fail to make its plea good, then the above obligation to be void; else to remain in full force and virtue.

[Seal of Company.]

JAMES S. TAPPAN. [SEAL.]
C. W. ROBERTS, *Sec'y.* [SEAL.]

Approved.
H. W. BLODGETT, *Judge.*

(Endorsed:) Filed May 23, 1890. Wm. H. Bradley, clerk.

39 NORTHERN DISTRICT OF ILLINOIS, *ss:*

I, William H. Bradley, clerk of the circuit court of the United States for the northern district of Illinois, do hereby certify the above and foregoing to be a true and complete transcript of the record of all the proceedings had in said court in the cause wherein The Dable Grain Shovel Company is plaintiff and Edward E. Flint and James W. Odell are defendants as the same appears from the records and files of said court now remaining in my custody and control.

Seal of Circuit Court U. S., Northern Dist. Illinois, 1855.

In testimony whereof I have hereunto set my hand and affixed the seal of said court, at my office, in Chicago, in said district, northern division, this twenty-seventh day of May, 1890.

WM. H. BRADLEY, *Clerk.*

40 UNITED STATES OF AMERICA, } ss:
Northern District of Illinois, }

THE UNITED STATES OF AMERICA:

To the judges of the circuit court of the United States for the northern district of Illinois, Greeting:

Because in the record and proceedings, as also in the rendition of a judgment in a plea which is before you, in said circuit court, between The Dable Grain Shovel Company, plaintiff, and Edward E. Flint and James W. Odell, copartners by the firm name of Flint, Odell and Company, defendants, in an action of trespass on the case, a manifest error hath happened, to the great damage of the said The Dable Grain Shovel Company, plaintiff, as by its complaint appears, and it being fit that the error, if any there has been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, you are hereby commanded if judgment be given therein, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at Washington on the second Monday of October, A. D. 1890, in the Supreme Court to be then and there held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the law and custom of the United States should be done.

Seal of Circuit Court U. S., Northern Dist. Illinois, 1855.

Witness the Hon. Melville W. Fuller, Chief Justice of the Supreme Court of the United States, this ninth day of April, in the year of our Lord one thousand eight hundred and ninety, and of the Independence of the United States the 114th year.

WM. H. BRADLEY,
Clerk U. S. Circuit Court, Nor. Dist. Ill.

[Endorsed:] Supreme Court of the United States. The Dable Grain Shovel Company, plaintiff in error, *vs.* Edward E. Flint and James W. Odell, copartners, &c., defendants in error. Writ of error. Copy deposited for the defendant in error in the clerk's office U. S., northern district of Illinois.

41 UNITED STATES OF AMERICA, } ss:
Northern District of Illinois, }

To Edward E. Flint and James W. Odell, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the second Monday of October, A. D. 1890, pursuant to a writ of error filed in the clerk's office of the circuit court of the United States for the northern district of Illinois, wherein The Dable Grain Shovel Company is plaintiff and Edward E. Flint and James W. Odell, defendants, to show cause, if any there be, why the error mentioned

should not be corrected and speedy justice should not be done to the parties in that behalf.

Witness the Hon. Henry W. Blodgett, judge of said court, this twelfth day of May, in the year of our Lord one thousand eight hundred and ninety.

H. W. BLODGETT, *Judge.*

Copy of the above writ served on us this 12th day of May, 1890.
BANNING & BANNING & PAYSON,
Attorneys for Defendants.

[Endorsed:] Supreme Court of the United States. The Dable Grain Shovel Co. *vs.* Edward E. Flint *et al.* Citation to October term, A. D. 1890.

42 To the Supreme Court of the United States:

In the Matter of the Petition of THE DABLE GRAIN SHOVEL COMPANY, Appellant.

Assignment of Errors.

Afterwards, to wit, on the second Monday of October, at the October term for the year eighteen hundred and ninety of the Supreme Court of the United States, at the Capitol, in the city of Washington and District of Columbia, comes the said "The Dable Grain Shovel Company," by its attorney, Wm. Zimmerman, and says that in the record and proceedings in the above-entitled matter there is manifest error, in this, to wit:

1st. That the matters of justification in defendants' first, second, third, fourth, and fifth pleas are not a good defense in law.

2nd. That the decision of the court below is not in accordance with analogous cases decided by this court.

3rd. That the court erred in its interpretation of the stipulation between the parties.

4th. That according to the admission of the defendants the assignor of the plaintiff had never abandoned his invention nor acquiesced in defendants' use of the same, and therefore demands compensation when he had his patent for the use of his invention.

5th. That sec'n seven of the patent act of 1839 (5th Stat. at Large, 353), as applied by the court below to this case, is unconstitutional and void.

Wherefore the said "The Dable Grain Shovel Company" prays that the order of said circuit court of the United States for the northern district of Illinois be reversed, and that said court be directed to enter judgement in accordance with the requests in the plaintiff's declaration.

WM. ZIMMERMAN,
Attorney for Appellant, 164 *Dearborn Street, Chicago, Ill.*

Endorsed on cover: N. Illinois C. C. U. S. No. 1213. The Dable Grain Shovel Company, plaintiff in error, *vs.* Edward E. Flint and James W. Odell, copartners as Flint, Odell & Company. Filed July 12, 1890.

Office Supreme Court U. S.
FILED.
OCT 13 1890
JAMES H. McKENNEY,
CLERK.

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A D. 1890.

THE DABLE GRAIN SHOVEL COMPANY,
Plaintiff in Error,
vs.
EDWARD E. FLINT AND JAMES W. ODELL, COPARTNERS AS FLINT, ODELL & COMPANY,
Defendants in Error.

No. 1213.

In Error to the Circuit Court for the Northern District of Illinois.

BRIEF AND ARGUMENT FOR PLAINTIFF IN ERROR.

WM. ZIMMERMAN,
ATTORNEY FOR PLAINTIFF IN ERROR.

IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D, 1890.

THE DABLE GRAIN SHOVEL COMPANY,
Plaintiff in Error,
vs.
EDWARD E. FLINT AND JAMES W. ODELL, COPARTNERS AS FLINT, ODELL & COMPANY,
Defendants in Error.

No. 1213.

In Error to the Circuit Court for the Northern District of Illinois.

STATEMENT OF THE CASE.

In 1866 John Dable was the mill-wright employed by the defendants in their grain elevators where he put his improved grain-shovel, which proved to be the first successful machine of its kind then known, as was proved on the trial in the court below in a prior case referred to in the declaration. The inventor took immediate steps to secure letters patent, filing his application December 23, 1865, which was allowed August 7, 1866, and numbered 56,906. After having made his first application he applied a second time for other improvements shown, but not claimed in his first application, for which he obtained Letters Patent No. 80,276, dated July 28, 1868.

The defendants were fully informed of the inventor's steps and intentions, notwithstanding which they ordered all the improvements, in both said inventions, to be put into their elevators.

Upon obtaining his letters patent the inventor made a formal demand for compensation for the use of his inventions, and was refused. Suit was then brought by John Dable against other parties, who, with these defendants, formed a part of a syndicate, or combination, which controlled the business in which the said inventions were used. Judgment was obtained, but owing to the inability of the plaintiff to force his rights to the end, he accepted an offer for settlement which, after all his expenses were paid, left him financially unable to reassert his rights. In 1880 the patents were assigned, "together with all "claims and demands of every kind and nature for past "infringements, and all rights of action whatever arising "out of, or connected therewith," to the Dable Grain Shovel Company, which then instituted this action at law for the infringements of said letters patent.

Said patents and assignments are filed as a part of this record.

The errors assigned in the record are.

1st. That the matter of justification in defendant's first, second, third, fourth and fifth pleas are not a good defense in law.

2d. That the decision of the court below is not in accordance with analogous cases decided by this court.

3d. That the court erred in its interpretation of the stipulation between the parties.

4th. That according to the admission of the defendants the assignor of the plaintiff had never abandoned

his invention, nor acquiesced in defendant's use of the same, and, therefore, demanded compensation when he had his patent for the use of his inventions.

5th. That Sec. 7 of the Patent act of 1839 (5th Stat. at Large, 354), as applied by the court below to this case is unconstutional and void.

AS TO THE DEFENDANT'S FOURTH AND FIFTH PLEAS:

The judgment of the court below is in error, because:

1st. New inventions are private property. (Const. Art. 1, Sec. 8, Cl. 8.)

2d. Letters patent must grant an *exclusive* right. (Const., Art. 1, Sec. 8, Cl. 8.) Therefore, section 7 of the patent act of 1839 is unconstitutional, *because:*

1st. It takes away the exclusive right granted in the constitution.

McKeever v. *U. S.*, 18 Ct. Claims, 757.
U. S. v. *Palmer*, 128 U. S., 262.
Cammeyer v. *Newton*, 94 U. S., 225.
Seymour v. *Osborne*, 11 Wall., 616.
Taylor v. *Thomas*, 22 Wall., 479.

2d. It permits the taking of the private property of the inventor and prohibits his right to compensation, which is against the fundamental law. (Const., 5th Amendment.)

3d. *It is unjust.*

(1.) *To the inventor.*

(2.) *To the public at large.*

(3.) *It is special*, because it favors those only who by any means (right or wrong) have obtained the knowledge necessary to make the "newly invented machine, "manufacture or composition of matter" devised by the inventor, and who put it into form before the inventor applied for a patent, *by making it lawful for such parties "to both use and vend such invention without liability there-"for to the inventor or any other person interested in such "invention."*

4th. *It is silent on an "art," or process*, enumerated in section 6, Patent act of 1836, which, because so omitted, cannot be within the meaning of section 7 of the Patent act of 1839, and, therefore, cannot, like a "machine, manufacture, or composition of matter" be appropriated without consideration, to the inventor as said other contrivances may be, namely, "*machines, manufactures, or composition of matter.*" It is, therefore, special and consequently unconstitutional.

U. S. v. *Babbitt*, 66 U. S., 55.

5th. *It establishes injustice.*

(1.) *Between inventors*, because it discriminates between them, without reason, as to the kind of invention which may or may not be appropriated without compention (4).

(2.) *Between the favored few* (3) *and the inventor.*

(3.) *Between the general public and the special parties* (3) who, the latter, may, by this statute, appropriate the inventor's property without being obliged to remunerate him.

(4.) *Between both the inventor and the general public on one side and on the other side the favored few*, who

gained advantage of another's toil without price and are upheld therein by such a law against both of said former parties.

Patent Act of 1839.

The specific clauses of section 7 of the act of 1839, stated in their natural or logical sequence, enact, *first*, that proof of abandonment of the invention to the public must be made before a patent can be declared invalid; *second*, that the inventor shall have two years' time to permit public use and sale of his invention before abandonment can be presumed and during which time application for a patent must be made; *third*, then, it says, that "every person or "corporation who has or shall have purchased or con- "structed any newly invented machine, manufacture, "or composition of matter prior to the application by the "inventor or discoverer for a patent shall be held to "possess the right to use and vend to others to be used "the specific machine, manufacture or composition of "matter, so made or purchased, without liability therefor "to the inventor or any other person interested in such "invention."

That there is a special protection provided for a certain class of persons in the latter clause, is plain; and who they are is self-evident, as well as what they shall not be required to do. It is to be those who have either themselves constructed or caused to be constructed, or those who have purchased of those who have so constructed or caused to be constructed the specific machine, manufacture or composition of matter. A special class of persons are to be protected from liability to the inventor because they constructed such invention before the inventor applied for his patent.

The inventor's consent or allowance is not to be asked. How those parties got the knowledge to make and use the invention is to be immaterial; that they got the knowledge and made the machines and own them, either through construction, or purchase from *tort feasors*, or others, is to be an all-sufficient reason to bar the inventor from making any claim on such parties for the right to use his invention.

The constitution nowhere prohibits special legislation in express and special terms, but there is no authority whatever to pass such a law unless sanctioned by public policy, as in the granting of patents for inventions and in copyrights, etc., where the party first earns the right to such favor. But to favor, and even encourage, by legislation, those who appropriate the fruits of toil and genius of others, and who have given no equivalent whatever for such privilege; or to make a distinction between inventors of a "machine, manufacture, or composition "of matter," and an "art," or process, which includes the former and exempts the latter, as is done under this law, is to subvert the very foundation of our great social compact, which from the very nature of things must be prohibited by implication as undeniable and potent as if it had been in the letter of the constitution. "What is implied in the constitution is as much "a part of the instrument as what is expressed."

U. S. v. *Babbit*, 66 U. S., 55: *U. S.* v. *Freeman*, 3 How., 556; *Ex parte* Yarborough, 110 U. S., 651; *Cunningham* v. *Neagle*, 135 U. S., 1; *Pumpelly* v. *Canal Co.*, 80 U. S., 166.

Viewed in every possible light section 7 of the patent act of 1839, fails to reveal that form which is demanded in a government "established to do justice and to promote

" the general welfare," and, hence, it is hostile to the first great principles of the social compact.

Calder v. *Bull*, 3 Dall., 386; *Van Horne* v. *Dorrance*, 2 Dall., 304; *Taylor* v. *Thomas*, 22 Wall., 479; *Marbury* v. *Madison*, 1 Cranch, 137; *Bank of Hamilton* v. *Dudley*, 2 Pet., 492; *Watson* v. *Nevin*, 128 U. S., 578.

A patent for a new invention is an executed contract on the part of the people who, through the constitution, have held out certain inducements as a reward for such labor, which is to be an *exclusive* right for a fixed time in such invention.

McKeever v. *U. S.*, 18 Ct. Claims, 757; *Lowell* v. v. *Lewis*, 1 Mass., 182; *Grant* v. *Raymond*, 6 Pet., 218; *Blanchard* v. *Sprague*. 2 Story, 164; *Howe* v. *Underwood*, 1 Fish. P. C., 160; *Hovery* v. *Stevens*, 3 Woodbury & Minot, 17; *Hunt* v. *Howe*, 1 McArthur, 366; *Wintermute* v. *Redington*, 1 Fish, P. C., 239; *Page* v. *Ferry*, 1 Fish, P. C., 298; *Savary* v. *Lauth*, 1 McArthur, 691; *Goodyear* v. *Providence Rubber Co.*, 2 Cliff., 351; *Royer* v. *Coupe*, 29 Fed. Rep., 358.

That a new invention is private property is conceded by the very proffer of the inducements named in the constitution which thus acknowledges the common law rig ht to both authors and inventors in their special productions and places them both on the same footing. This fundamental right has been acknowledged in copyright in

Crowe v. *Aiken*, 2 Biss., 208; *Jones* v. *Throne*, 1 N. Y. Leg. Obs., 408; *Wheaton* v. *Peters*, 8 Pet., 591; *Bartlett* v. *Crittenden*, 5 McLean, 32; *Paige* v. *Banks*, 13 Wall., 608; *Palmer* v. *DeWitt*, 47 N. Y., 532; *Consolidated Fruit Jar Co.* v. *Wright*, 94 U. S., 92.

Therefore there can be no time, after which an inven-

tion is completed, during which there is not a common law protection to the inventors' rights just as much as there is to the work of an author.

If these views, as expressed by those courts, are correct then the maxim that "[private] property cannot be "taken [for public use] without just compensation," must apply to patent cases as well. And on this point this court says in *Pumpelly* v. *Canal Co.*, 80 U. S., 560. "This power to take private property reaches back of "all constitutional provisions, and it seems to have been "a settled provision of universal law that the right to "compensation is an incident to the exercise of that "power; that the one is inseparably connected with the "other; that they may be said to exist not as separate and "distinct principles, but as parts of one and the same "principle," quoting *Sinnickson* v. *Johnson*, 2 Harr., 129, N. J., and continuing; the court further says:

"In *Gardner* v. *Newberry*, 2 Johns. Ch., 162, Chancel- "lor Kent says it is a clear principle of natural equity "that the individual whose property is thus sacrificed "must be indemnified." And for self evident reason of even greater force this principle applies to inventors and authors.

From the moment the inventor has completed his invention he is entitled to the promised reward, namely, *the exclusive right to his invention.* That congress has interposed necessary formalities and conditions which cause the delay to a full and complete recognition of the inventor's right, at the moment his invention is complete, is no fault of the inventor, and cannot be made an excuse through which others can obtain advantage of the fruits of the inventors toil without remuneration to him.

Kendall v. *Winsor*, 21 How., 322.
Pennock v. *Dialogue*, 2 Pet., 1.
Shaw v. *Cooper*, 7 Pet., 292.
McClury v. *Kingsland*, 1 How., 202.

Any law which will give to others a right, at any time within the life of a patent, to appropriate an invention, in whole or in part, which will deprive the inventor of the complete realization of his contract, must be in violation of the constitution.

Fletcher v. *Peck*, 6 Cranch, 87; *Dartmouth College* v. *Woodward*, 4 Wheaton, 518; *Pumpelly* v. *Canal Co.* 80 U. S. 560; *Taylor* v. *Thomas*, 80 U. S., 479.

In the concurring opinion of Mr. Justice Story in the Dartmouth college case he says: "A contract executed "is one in which the object is performed and this says "Blackstone differs in nothing from a grant. A contract "executed as well as one that is executory, contains obli- "gations binding on the parties. A grant in its own "nature amounts to an extinguishment of the rights of "the grantor and implies a contract not to reassert that "right. A party is always estopped by his own grant."

And in another case Chief Justise TANEY's words are:

"The franchise which the patent grants consists alto- "gether in the right to exclude every one from making, "using or vending the thing patented without the per- "mission of the patentee. This is all that he obtains by "the patent."

Bloomer v. *McQuewan*, 14 How., 539.

AS TO THE DEFENDANTS SECOND PLEA.

State laws cannot apply to actions exclusively federal.

Prigg v. *Commonwealth of Penn.*, 16 Pet., 539; *Swift* v. *Tyon*, 16 Pet., 1; *Stuart* v. *Laird*, 1 Cranch, 299; *Martin* v. *Hunter*, 1 Wheaton, 304; *Cohn* v. *Commonwealth of Virginia*, 6 Wheaton, 264; *Houston* v. *Moore*, 5 Wheat., 1, 21, 22; *Sturgis* v. *Crowinshield*, 4 Wheat., 122; 1 Kent, 389.

The court was unanimous in all its opinions on this point.

In *Prigg* v. *Commonwealth of Penn.*, 539, (see from page 636) Mr. Justice WAYNE sums up the conclusion of the court thus:

"I concur altogether in the opinion of the court. In "that is decided 1st—2d—3d—that the legislation by Con- "gress upon the provision, as the supreme law of the land, "excludes all state legislation upon the same subject, and "that no state can pass any law or regulation, or inter- "pose such as may have been a law or regulation when "the constitution of United States was ratified, to super- "add too, control, qualify, or impede a remedy, enacted "by Congress."

"4th. That the power of legislation by Congress upon "the provision is exclusive, and that no state can pass any "law as a remedy upon the subject, whether Congress "had or had not legislated upon it." 5th—6th—7th— "All the members of the court concur, that if legislation "by Congress be necessary, that the right to legislation "is exclusively in Congress."

Our national government is complete in itself with

power which neither depend on nor can be abridged by state laws:

Weston v. *Charleston*, 2 Pet., 499; *McCullough* v. *Maryland*, 4 Wheat., 316; *Osborn* v. *U. S. Bank*, 9 Wheat., 738.

AS TO THE DEFENDANTS THIRD PLEA, VIZ:

That the patentee could not assign his right of action so as to enable the plaintiff to maintain an action in its own name.

Section 4,898 R. S. provides that "Every patent, or "any interest therein shall be assignable"—both by the "patentee or his assigns or legal representatives" as well as claims growing out of and adhering to property.

Comegys v. *Vasse*, 1 Pet., 213; *Adams* v. *Bellaire Stamping Co.*, 25 Fed. Rep., 270; *Moore* v. *Marsh*, 7 Wall., 515.

Damages for infringements may be recovered in the name of the party interested; *Adams* v. *Bellaire Stamping Co.*; construing *Moore* v. *Marsh*; *Gayler* v. *Wilder*, 10 How., 477; *Herbert* v. *Adams*, 4 Mas., 15; *Wilson* v. *Rousseau*, 4 How., 674, 675; *Gottfried* v. *Miller*, 104 U. S., 521, 520; *Cammeyer* v. *Newton*, 94 U. S., 225; *Bicknell* v. *Todd*, 5 McLean; *May* v. *Logan Co.*, 30 F. R., 469; *May* v. *Co. of Ralls*, 31 F. R., 473; *Washburn* v. *Gould*, 3 Story, 122.

A patentee may reserve to himself the right to prosecute for piracies within the particular district where the right of use is conveyed, but if he afterwards assigns all his rights to such district the owner of the patent may

sue. It would be unreasonable under the circumstances to call upon the patentee to prosecute.

Bicknell v. *Todd*, 5 McLean, 236.

In *McKeever* v. *U. S.*, the court says: "The Consti- "tution confers upon Congress the power of securing to "inventors the exclusive right to their discoveries. *Con- "gress are not empowered to grant to inventors a favor, but "to secure to them a right, and the term 'to secure a right "by no possible implication carries with it the opposite "power of destroying that right in whole or in part. * * * "without complying with that other condition of the Con- "stitution, the making of just compensation.*' Neither "does the term 'exclusive right' admit of an implication "that with regard to such patentable articles as the gov- "ernment may need the right shall not be exclusive. The "transfer of the power from the executive to the legis- "lature, the abandonment of the terms '*grant*' and "'*patent*'; the substitution of the words '*secure, right*,' "and '*exclusive*'; the absence of an express reservation "which at common law attaches to favors of the Crown "or is inferable from the terms 'grant' and 'patent,' are "facts which combine to demonstrate that the framers of "the Constitution designed to place the work of the in- "ventor among the legal rights which when properly se- "cured in a manner to be provided by law should become "*property* in the eye of the law and be respected as such "by the government as by the citizens."

It follows, then, as naturally as one step follows another that if a patent for an invention is property it is endowed with all the legal attributes of property and the holder of it is, therefore, entitled to compensation, upon which the court in above quoted case continues: "In Burnes case

"(12 Wallace R., 246) it was held that the inventor's "license to the government to use his patented invention "was a valid consideration to support an action for the "royalty." In *Cammeyer* v. *Newton*, (94 U. S., 223), in delivering the opinion of the court, Mr. Justice Clifford says: "The rule of law is well settled that *an invention* "*so secured is property in the holder of the patent*, and "that as such the right of the holder is as much entitled "to protection as any other property during the term for "which the franchise or the exclusive right or privilege "is granted." And alluding to the previous decision in "Burns' case, he adds (p. 234): "Agents of the public "have no more right to take such private property than "other individuals under that provision (Patent Act 1870, "16 Stat. L., p. 198, Sec. 22) as it *contains no exceptions* "*warranting any such invasion of the private rights of in-* "*dividuals.* Conclusive support to that proposition is "found in a recent decision of this court in which it is "held that the government cannot, *after the patent has* "*issued, make use of the improvement any more than a* "*private individual* without license of the inventor or "making him compensation. * * * *When a vendable article,* "*such as ordinarily is the subject of bargain and sale, is* "*offered by a producer to a consumer, though mith no* "*price specified and is accepted and used by the latter, it is* "*not to be supposed, on the one hand that the offer was in-* "*tended as a gift intervivos*, nor implied on the other that "the taking was with a tortious intent."

Even so in this case. When the inventor said that he could make the machines work by applying his inventions, he was told to put them into practical form, and as they proved to be successful, the defendants ordered all their places to be provided with those new machines. The

lawful presumption that he should be paid what the inventions were reasonably worth was implied in that order.

Noonan v. *Bradly*, 9 Wall., 394, citing (407 *Mayer* v. *Isaac*, 6 Mees & W., 612); *Gelpcke* v. *Dubuque*, 1 Wall, 222; *McKeever* v. *The U. S.*, 18 Ct. Claims, 757; *U. S.* v. *Palmer*, 128 U. S., 262.

The injury that may be done to the inventor through such an unjust law extends beyond a single one, or a few of his machines; for it may so happen that an invention may be used in but a single establishment or place, or in but a few places in the whole country, as in the case at bar; and then how easy it might happen that the patent for which he had been taxed $35 would be utterly worthless, because all who had need of such machines had supplied themselves before the inventor could obtain the necessary funds to pay for his patent; or, as in this case, the defendants simply asked the inventor to put his machine in their establishment, and he complied with their request, supposing, beyond a doubt, that it should be for such consideration as they would reasonably be worth. But when he asked them for such remuneration, after he had his patent, they replied: "We got our machines "before you applied for your patent; we owe you noth-"ing by the statute." Could a law more ungraciously unjust be imagined?

This court has never directly dealt with or recognized this particular question of the statute, because it always presented in forms which turned more or less on other considerations, and whatever recognition it received has been overruled by a unanimous vote in:

McKeever v. *The U. S.*; *Beedle* v. *Bennet*, 122 U. S., 71; *U. S.* v. *Palmer*, 128 U. S., 262; *McClury* v. *Kings-*

land, 1 How., 202, *Stimpson* v. *Chester R. R. Co.*, 4 How., 380; (see 429, 4 Bx.); *Pierson* v. *Eagle Screw Co.*, 3 Story, 408; *Jones* v. *Sewall*, 3 O. G., 650; *Agawan* v. *Jordan*, 7 Wall, 583; *Kendall* v. *Winsor*, 21 How., 233; *City of Elizabeth* v. *Paving Co.*, 97 U. S., 126; *Andrews* v. *Hovey*, 124 U. S., 694; *Bloomer* v. *McQuewan*, 14 How., 539; *Bloomer* v. *Milligan*, 68 U. S., 340; *Adams* v. *Burke*, 84 U. S., 453; *Birdsall* v. *Shiloal*, 112 U. S., 485; *Wade* v. *Metcalf*, 129 U. S., 202.

In both *Pierson* v. *Eagle Screw Co.*, and *Consolidated Fruit Jar Co* v. *Wright*, it is held that "the first clause "of Sec. 7 Act of 1839, is very general; not to say loose."

In the former case Mr. Justice Story explains the meaning of the decision in *McClury* v. *Kingsland*, and also expresses other opinions in regard to this section which have been approved in all succeeding opinions of the courts, and which have herein been set out and followed substantially on the grounds there given.

Reply to Defendant's Argument.

STATUTORY LICENSE.

The chief point relied upon in the argument of the defense is that "they had the right to use those inventions, "by operation of law."

This position is unsound because, by the *constitution*, by the *statute*, and by the *words of the patent* itself, the patentee holds the *exclusive* right. As the defendants hold, with the court below, that their construction of section 7 of the Patent act of 1839 is correct, we can only repeat our statement, that if such was the intention of congress that it should be thus construed, that it is inconsistent with the purpose of the constitution, and therefore void.

Another point raised by the defense, under their fourth and fifth pleas, is, that they used the invention "by an "implied agreement." But, an implied agreement also carries with it an implied right to compensation, which they admit they did not regard, never having paid, or offered to pay, for the right to use these inventions. This acknowledgment of their refusal to pay the inventor is admitted in their stipulation, namely: "that when the in- "ventor had his patent he demanded compensation," and at that time, because he could not set the machinery of the law in motion and make an enforcible demand at an earlier date.

After that time the right to use those inventions was John Dable's *exclusive* property.

As this exclusive control over the patent is a constitu-

tional right, section 7 of the Patent Act of 1839 cannot make a right so granted *less* than an exclusive right.

Under the circumstances the defendants are indebted to the inventor under an implied assumpsit just as much as they were for wages earned by him, or for the use of a horse at their mere request and owner's assent, although no price therefor had been agreed upon.

There is no question of a gift of such service, and it is so admitted both in the pleadings of the defense and their stipulation. Moreover, sane men do not do business in that way, namely, work at wages for a concern and make valuable inventions, useful only in its line of business, and make a present thereof to them, and at the same time secure the right to the invention by a patent, without even a penny for such service.

If the defendants ever had a just claim for material, time, etc., against the inventor, as set out in their fourth and fifth pleas, they would have presented their bill for the same, and deducted the amount from Mr. Dable's weekly salary. But quite the contrary, as the record of the court mentioned in the declaration fully show, they were evidently very glad to be helped out of a serious loss and very willing to give all necessay time, material and money, to gain that end without charge, because, if successful, it would be of great profit to them, as facts afterwards proved it to be.

Having thus by their acts proved that they made a gift of such time, material, etc., they cannot, at this late date, repudiate their acts and now claim the right, under the statute, to make a charge set by themselves upon the inventor's property, which, in value, is in collossal proportions to their expenditure in the experiment, and which was made at their instance and for their great profit.

Again, if the making of the first machine was an experiment to which these defendants could have a right, as claimed under the statute, it could then be for only one and not seventeen machines; for the other sixteen, as is clearly apparent, were merely duplicates of the first machine and of both patents.

It is not possible to perceive by what authority Congress can enact special laws which discriminate against inventors and which shall deprive them of the right to dispose of their inventions as freely as owners of other property may do, especially in view of the constitutional provision that the patent law shall be made to *promote* the progress of science and the useful arts. Under this constitutional condition it is not at all perceived how Congress can enact a law which will encourage tort-feasing upon inventors by giving special protection to those who have through unjust acts succeeded in appropriating the fruits of the inventor's toil before he had his patent, or where an inventor's art shall be construed most unfavorably against him so as to favor a party who only knows how to appropriate, but not to create, the invention.

Such reasoning and such law seem to be entirely unsound.

In *Pierson* v. *Eagle Screw Co.*, 3 Story, 408, Mr. Justice STORY says:

"Certainly the language of the first clause of seventh "section of the act of 1839 is very general, not to say "loose—the language does not even include the qualifi- "cation that the purchaser should be *bona fide*, for a "valuable consideration—or free from any fraud upon the "vendor. Yet surely it could never have been the inten- "tion to confer on a fraudulent purchaser a right pirated "from the inventor.

"If on the other hand we interpret the clause to mean "a purchaser from the inventor before his application for "a patent, the ommission of such qualifying words is at "once material and consistent with the apparent object of "the section."

We accept, with a future qualification, this interpretation of that venerable and eminently learned jurist and say that that was as far as the court was called upon to decide in that case, but we deny the right of Congress to enact a law with such an apparent object.

Why should Congress assume that inventors, as a class, are so grossly unscrupulous as to demand compensation a second time for their inventions, and that it would therefore be necessary to enact such a law to protect the purchasers of their inventions. Has experience warranted such a conclusion and proved, in the slightest degree, a greater need for such a law than in the case of vendors of any other species of property? If this conclusion be the true interpretation of this section, has Congress the right to pass a law which would be an insult to a class upon whom all mankind depend, soley, for their progress whom the constitution specially recognizes as a pre-eminently useful class and against whom no such accusations can be sustained?

We repeat, therefore, that Congress has no authority, on the one hand, to enact any law which shall in any way tend to reflect discredit or cast reproach upon any of the citizens of this country, or, on the other hand, pass laws which shall discriminate against any class, and especially, and least of all, against its inventors, and in favor of those who trespass upon their rights.

Why should inventors, as a class, be singled out as the

ones against whom such special legislation should be deemed to be necessary, when authors as another class, though standing under precisely the same constitutional protection, and who ought, therefore, to be presumed to be equally liable to make a second demand upon a purchaser for renumeration, be exempted from such law? Could Congress really have meant to thus humiliate one class out of two of those which the constitution has so exalted? Could clearer proof be required than the experience showing that if one class does not need such legislation; that the other class, namely, the inventors never needed it?

Whatever view this court may take as to either one of those clauses in relation to the other, are they not both void, because unauthorized, and is not, therefore, under either position, as we hold, the entire section unconstitutional?

Plaintiff does not deny the correctness of the defendant's, when they claim that Congress has full power to prescribe any and all conditions which may seem wise, but it denies the right of Congress to act *ultra vires*, and insists that it is limited by the constitution; and says that if by that instrument an inventor shall have an exclusive right in his invention for a limited time, it is beyond the power of Congress to say that he shall have *less* than an exclusive right.

There is still another point to be considered. Even if all the other points held by the defense in regard to section 7 of the act of 1839 could be held to be sound, and that is, that under that act (and perhaps more definitely, in section 4899) Congress virtually prescribes the consideration which the inventor must give for the assistance that parties may see fit to render him. How does it lay within

the power of Congress to say what is "just compensation for private property?" This right to name a price for one's own property is of a higher order than even the constitution presumed to prescribe, and it cannot be interfered with by any legislature, and was therefore clearly beyond the power of Congress to enact.

The constitution (Art. 1, Sec. 8) directs that "inventors shall have an *exclusive* right in their inventions, "etc."; and in Art. 5, that "private property shall not "be taken for (public) use without just compensation." Therefore, the defense is without force unless it can show that a law justifying the taking of patent property is of higher import than this constitutional provision.

If the position of the defense is true, namely, that "everybody is at liberty to use his (the inventor's) invention, before he gets his patent," and may continue to do so after that time, as these defendants have done, on such supposed authority, what becomes of the statutes of 1836 and 1839? Can they work only in favor of the defense? The statute then, as now, gives the inventor two years' time within which he may apply for a patent. Is not this a statutory right and is not the inventor complying with the law if he makes his application before that time? And has he not, at least, an inchoate right to his invention before, which becomes consummate at the date of his patent? The mere mention of these axiomatic statements ought to be sufficient. Therefore, that inchoate right, when perfected by the issuing of the patent, becomes by law a *perfect* and an *exclusive* right.

This, clearly, was the intention of the framers, as well as of the approvers, of the constitution. They, by their votes, declared that "we will protect the work of the author and of the inventor, and recognize the fruits of

" their efforts to be their lawful property, as fully as we " do that of other property, if the common law does not, " or is insufficient, and we will grant to and protect them " in an exclusive right," etc.

Another point in the argument of the defense is, that " by the 'common law' an inventor had no right of prop- " erty in his invention, and that whoever wished, there- " fore, might appropriate the fruits of an inventor's toil " to his own use."

To this the plaintiff replies, that if reference is had to the time when our ancestors were in a state of semi-civilization, it is quite likely that they held such views as to what made their common law to them, then, as our views make our common law to us at the present day.

But the law, like the beings over whom it rules, is susceptible of refinement, and becomes refined in the same degree as its subjects become refined and enlightened, and that in just that measure they recognize each other's rights.

The law is only expressed in written form where found necessary, and is then called " statutory." " A statute is " only a declaration of specially recognized common law " principles."

This view of the common law was so stated by Lord Coke; Co. Litt, 76 a, 290 b, and applied by Lord Mansfield in *Cadagen* v. *Kennett*, Cowp., 434, and also adopted by this court, speaking through Chief Justice Marshall in *Hamilton* v. *Russel*, 1 Cranch., 309. The same idea is again expressed by this court in *Stevens* v. *Gladding*, through Mr. Justice Curtis, where it says: " There is " no common law of copyright in this country." 17 How., 477.

In other words, then, according to these eminent authorities the constitution of the United States is but a broad general declaration by the people of their views and wishes as to what their common (general) law shall be; a guide and basis upon which their special (statute) laws shall be founded, all being based on our modern idea of the common or unwritten law, our modern idea of right and wrong, to which the ancient common law must always adapt itself.

This interpretation we believe to be the true definition of what the common law should be regarded to be, because it is intelligible to every cultivated as well as legal mind, and because it is free from all mystification or theories which clash with our modern ideas of *right*.

Taken, then, from the standpoint of those great authorities, the common law is in harmony, instead of being discordant, with the constitution of the United States, as the defense would make it to be on their theory of what the common law right of the inventor, and the public, to his invention is.

The plaintiff holds, therefore that the general opinion of the people would, to-day, irrespective of the constitution and statute, assert that the right of the inventor to his invention is his alone, as absolutely as in his every chattel, because *their general opinion is their* COMMON LAW, and that common law was expressed by the adoption of their constitution.

STATE STATUTES OF LIMITATION.

That state statutes of limitation cannot apply to questions purely federal has been so frequently decided in the negative, that it would seem that it ought to be considered settled.

The defense argues that at least seven cases have held that state statutes of limitation are applicable to patent cases.

The identical cases cited by the defense were considered together with eighteen other cases by plaintiff in its argument in the court below; they are a part of twenty-five cases having special reference to this subject, out of which only four can be said to hold the affirmative view, namely: *Sayles* v. *Rich'd Fred'bg & Pt. Ry.; Parker* v. *Hawk*; *Parker* v. *Hall* and *Rich* v. *Ricketts.*

Parker v. *Hawk* and *Parker* v. *Hall*, were decided on the authorities of *McCluney* v. *Silliman*, 3 Pet., 270. That was an action on the case against the register of a land office in Ohio for non-feasance, in refusing a request to enter an application for the purchase of certain government lands, and therefore came under section 34, or, present, 721 of judiciary act. *Parker* v. *Hall*, and *Rich* v. *Ricketts*, were decided on the same authority, citing also *Leffingwell* v. *Warren*, 2 Black., 599; and the court is of opinion that like authorities are numerous. But this last, like all other authorities, cited on this side of the question, was a cause cognizable in a state court, it being an action for ejectment.

Sayles v. *Rih'd Fdbg. and Pot. R'y* is decided on the authority of *Sohn* v. *Waterson*, 17 Wall., 596, which was an action to recover the amount of a judgment rendered in Ohio, against a party of Kansas. The court next cites *Ross* v. *Duoall*, 13 Pet., 62. In this case the court in support cites *Lewis* v. *Lewis*, 7 How., 778. Here the cause of action was covenant for land.

The foregoing are, practically, all the cases which hold that state statutes of limitation apply to patent cases.

Sayles v. *R. R. Co.*, when properly examined, will be found to be on the contrary side from that stated by the defense.

None of the cases cited are exclusively federal. It is also true that this court has decided, in the four cases cited by the defense, that state statutes relating to evidence, and interest on money, apply to federal (not patent) cases; and there are, undoubtedly, many more such cases to be found; but it has never decided that state statutes of limitation apply to patents, or any other matter exclusively federal. When interest is charged on money derived through a patent it is no longer a patent case, but simply a debt.

That Congress repealed the special statute of limitation in patent cases in 1870, and enacted no other law on that subject does not put state statutes of limitation in force, because, under the authority of the constitution, they could not be made to apply, and it was so held in many of the above mentioned twenty-five cases considered in the circuits on this special subject.

Suit by Assignee.

As inventions and rights under them are assignable, by law, there can be no question as to the plaintiff's right to sue in its own name for rights accrued before it acquired title. In *Wilson* v. *Rouseau*, 4 How., 674, 675, this court said: "Unless the executor or administrator is permitted "to take the place of the patentee in case of his death "* * * the object of the statute will be defeated. * "* * In its nature patent property passes as part of the "effects of the estate." In *Hendrie* v. *Sayles*, 98 U. S.,

550, this court says: "The assignee acquires only the "exclusive right to make use and vend," etc. * * * "*Unless the assignment contains words showing that the instrument should be more comprehensive*," thereby implying that it may be more comprehensive; and in 92 U.S.,p. 728, in *Hammond* v. *The Mason, etc., Co.*,this court says: "We are of opinion that the rights growing out "of an invention may be sold." In *Gaylor* v. *Wilder*, 10 How., 494, it is held that "the legal right to the "monopoly * * * is vested in the assignee," and he, therefore, was the proper person to bring suit; and on page 93, the same court says: "An incohate right in "a patent is assignable," and also said that "no good "purpose would be answered by holding a different "opinion."

In *Adams* v. *Bellaire Stamping Co.*, 25 F. R., 270, Sage, J., says that the assignee has the right to sue at law in his own name for past infringements; if the assignment conveys them, which, he held, was the point decided in *Moore* v. *Marsh*, 7 Wall 515. To the same effect isthe decision in *N. Y. Grape Sugar Co.*v.*Buffalo Grape Sugar Co.*, 18 F. R., 632.

The same opinion is expressed in *Jenkins* v. *Greenwold*, 1 Bond, 126, and in *Gear* v. *Fitch*, 15 O. G., 1231, the question was regarded as fairly settled. To the same effect is the opinion of the court in *Spring* v. *Domestic Sewing M. Co.*, 22 O. G., 1445; *Gordon* v. *Anthony*, 16 Blatch., 234; *Boomer* v. *United Power Press Co.*, 13 Blatch., 107; *Henry* v. *Francistown Soapstone Stove Co.*, 9 O. G., 408; *Hamilton* v. *Rollin*, 5 Dill, 495; *Koalatype Engraving Co.* v. *Hoke*, 30 Fed. Rep., 444: *May* v. *Juneau Co.*, 30 Fed. Rep., 241; *Merriam* v. *Smith*, 11 Fed. Rep., 588; *May* v. *Co. of Logan*, 40 F. R., 250.

In *May* v. *Co. of Logan*, 30 F. R., 250, the court says: "It is hardly an open question at this day that a patentee's "right of action for an infringement of his patent sur- "vives to his personal representatives," and in *Bicknell* v. *Todd*, 5 McLean, 236, the court says: "It would be "unreasonable in such a case to call upon the patentee "to prosecute."

In *Wilson* v. *Rousseau*, this court says: "A patent is "not a mere personal reward, but an enlarged interest "and right of property in the invention itself made with "a view to secure to the inventor greater certainty and "a fair remuneration, and it is to be dealt with as other "rights of property belonging to him."

It is respectfully submitted that each and all of the several defenses are unsound, and, therefore, that the decision of the court below should be reversed, with judgment in favor of the plaintiff, and the plaintiff prays, therefore, accordingly.

WM. ZIMMERMAN,
Attorney for Plaintiff in Error.

Supreme Court, U. S.
FILED
OCT 13 1890
JAMES H. MCKENNEY,
CLERK.

Supreme Court of the United States.

OCTOBER TERM, A. D. 1890.

THE DABLE GRAIN SHOVEL COMPANY,
Plaintiff in Error,

No. 1213. vs.

EDWARD E. FLINT and JAMES W. ODELL,
Co-Partners as Flint, Odell & Company,
Defendants in Error.

In Error to the Circuit Court of the United States for the Northern District of Illinois.

BRIEF FOR DEFENDANTS IN ERROR.

EPHRAIM BANNING,
THOMAS A. BANNING,
Counsel for Defendants in Error.

EASTMAN BROS., LAW PRINTERS, 187 WASHINGTON ST., CHICAGO.

Supreme Court of the United States.

OCTOBER TERM, A. D. 1890.

THE DABLE GRAIN SHOVEL COMPANY,
Plaintiff in Error,

No. 1213. *vs.*

EDWARD E. FLINT and JAMES W. ODELL,
Co-Partners as Flint, Odell & Company,
Defendants in Error.

In Error to the Circuit Court of the United States for the Northern District of Illinois.

Brief for Defendants in Error.

May it please the Court:

This is an action at law to recover damages for infringement of letters patent Nos. 56,906 and 80,276, issued, respectively, August 7, 1866, and July 28, 1868, to John Dable, for Improvements in Machines for Unloading Grain from Railroad Cars. The patents are alleged to have been assigned to plaintiff December 8, 1880.

The defendants' second plea presents the question whether the State statute of limitations is applicable in a patent case; their third plea, the question whether an assignee of a patent can maintain an action at law in his own name for an infringement committed before he acquired title; and their fourth and fifth pleas, the question whether defendants did not have a right to use the inventions while the patents were in force by operation of law, or by an implied agreement arising out of circumstances therein mentioned. The plaintiff replied to the second and third pleas and the de-

fendants demurred to its replication; and the parties stipulated as to facts involved in the defenses presented by the fourth and fifth pleas. On this demurrer and stipulation the cause was submitted before Judge Blodgett, without a jury, and decided in defendants' favor.

Statutory License.

As the defense presented by the fourth plea is believed to be sufficient, and was so held in the Court below, it will be convenient to consider this plea first. Omitting its formal opening and closing, this plea is that—

> "The only machines for unloading grain from railroad cars ever used by them [defendants] during the life of either of said patents set forth in said declaration were constructed and put into use in their grain elevators by the said John Dable, and with his consent and allowance, while he was in their employ as superintendent of machinery, and prior to his application for either of said letters patent, and thereby, and by virtue of the statute in such case made and provided, the defendants became possessed of the right to use all said machines during the life of each of said patents, without liability to the said John Dable or the plaintiff." (6.)

The material part of the stipulation, on which the cause was submitted in the Court below, is that—

> "The facts stated in said fourth and fifth pleas are as therein stated, except that John Dable, the patentee, claimed compensation from the defendants for the use of his invention covered by his letters patent sued on, at the time he obtained said letters patent, respectively, which claim the defendants refused to recognize." (13.)

The fourth plea presents the defense of a statutory license or right to use the invention, by virtue of Section 7 of the Act of 1839, which was in force at the time the Dable patents were granted, and which provides that—

> "Every person or corporation who has or shall have purchased or constructed any newly invented ma-

> chine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention."

In substance, this provision was continued in Sec. 37 of the Act of 1870, with this qualification, that where the patented machine is not purchased from the inventor it must be constructed with "his knowledge and consent;" and, with this qualification, the same provision is now contained in Sec. 4,899, Rev. Stat. In this cause, however, the qualification in reference to "knowledge and consent" is immaterial (1) because the patents sued on were granted while the Act of 1839 was in force; and (2) because the machines in controversy are admitted to have been constructed and put into use by the patentee "or with his consent and allowance."

It will be noticed that, by its stipulation, plaintiff admits that the grain unloading machines used by defendants, and now charged to infringe the Dable patents, were constructed and put into use in defendants' elevators, by the patentee, while he was in defendants' employ, as superintendent of machinery, and "prior to his application for either of said letters patent." This certainly brings the case within the language of the statute, which gives to every person or corporation the right to use a specific machine purchased or constructed "prior to the application by the inventor or discoverer for a patent." In other words, these specific machines being constructed and put into their elevators before any application was made for a patent, defendants at once became possessed by virtue of the statute of the right to use such machines without any liability whatever to the inventor or his assignees.

The mere fact that the inventor afterwards, at the time he

obtained his patents, claimed compensation for the use of his inventions could in no way affect, impair, or take away the right thus already vested in defendants. If such a statutory license can be recalled at any time by a simple demand, why cannot any other license be recalled in the same way?

Judge Blodgett well says:

> "I do not see how a case could be made to bring the defense more clearly within the provisions of the statute than is made by this plea, and the additional fact stated in the stipulation does not change the effect of the plea. The plea is therefore held to be a complete defense to the suit." (15.)

The case is so clear that it hardly seems necessary to cite authorities; but we call attention to *Wade* v. *Metcalf*, 129 U. S., 202, 205, in which it was said "that the implied license conferred by the section sets the specific machine free from the monopoly of the patent in the hands of any person, just as if that person were the lawful assignee of one holding the machine under a purchase or an express and unrestricted license from the inventor."

But counsel for plaintiff in error contends that Sec. 7 of the Act of 1839 is unconstitutional. The principal ground on which he bases this contention is that such section detracts from the exclusiveness of the right granted in the Constitution, and that it permits the taking of the private property of an inventor without compensation.

In answer to his positions in this behalf it is only necessary to suggest that there can be no "exclusive right" or "private property" in an invention until after a patent has been granted. There is no common law right to an invention. Until the inventor complies with all the requirements of law, and obtains his patent, everybody is at liberty to use his invention.

> "The inventor of a new and useful improvement certainly has no exclusive right to it until he obtains a

patent. This right is created by the patent, and no suit can be maintained by the inventor against any one for using it before the patent is issued." *Gayler* v. *Wilder*, 10 How., 493.

"An inventor has no exclusive right to make, use and vend the improvement until he obtains a patent for the invention, and that is created and secured by the patent; nor can the inventor maintain any suit for infringing the same before the patent is issued." *Hendrie* v. *Sayles*, 98 U. S., 551.

"The right of property which a patentee has in his invention, and his right to its exclusive use, is derived altogether from these statutory provisions; and this Court has always held that an inventor has no right of property in his invention, upon which he can maintain a suit, unless he obtains a patent for it according to the Acts of Congress; and that his rights are to be regulated and measured by these laws, and cannot go beyond them." *Brown* v. *Duchesne*, 19 How., 195.

"The invention is the product of the inventor's brain and if made known would be subject to the use of anyone if that use were not secured to him. Such security is afforded by the Acts of Congress when his priority of invention is established before the officers of the Patent Office, and the patent is issued. The patent is the evidence of his exclusive right to the use of the invention; it may, therefore, be said to create a property interest in that invention. Until the patent is issued there is no property right in it—that is, no such right as invention can enforce. Until then there is no power over its use, which is one of the elements of a right of property in anything capable of ownership." *Marsh* v. *Nichols & Co.*, 128 U. S., 611–12.

"An inventor has no right to his invention at common law. He has no right of property in it originally. The right which he derives is a creature of statute and of grant, and is subject to certain conditions incorporated in the statutes and in the grants." *Am. Hide & Leather Co.* v. *Am. Tool Co.*, 4 Fisher, 294.

The cases cited by counsel are in no way inconsistent with the view here suggested—that an inventor has no exclusive right until his patent is granted. For instance, the language used in *McKeever* v. *U. S.*—that the term "exclu-

sive right" does not "admit of an implication that, with regard to such patentable articles as the Government may need, the right shall not be exclusive"—simply means that *after* a patent has been granted the right shall be exclusive. In other words, all such language has reference to the breadth or scope of a patent after its issuance—after the patentee becomes vested with a property interest—and not to matters occurring prior thereto and during the time the invention is open to the public, forming a part of our common property.

It would be as reasonable to say that, before filing his application, a patentee cannot grant a license by express agreement as to say that he cannot construct and sell his machines in such a way as to authorize their unrestricted use. On the one hand, it is often of great benefit and advantage to an inventor to be able to make and sell sufficient machines to test the practicability of his invention, or to obtain money with which to perfect, introduce or manufacture it, or to apply for a patent; and, on the other, it is only reasonable that innocent purchasers should be protected against claims under patents not even applied for at the time of their purchase. It would be simply monstrous to say that an inventor can sell a machine for full price, and then, obtaining a patent, turn around and enjoin use by the innocent purchaser of the very machine sold. Will this Court say that an inventor shall not be allowed to deal with the public at all before obtaining his patent? This will be the meaning of a decision in plaintiff's favor on the question here presented; for, of course, in the absence of protection to the public, inventors will be practically prohibited from dealing with the public. So that, looked at both from the stand-point of the inventor and the public, the provisions of the law in question rest upon a foundation of sound sense and reason.

If the patent is a creature of the statute, as this Court has

repeatedly said it is, it would seem to go without saying that it must be granted and accepted subject to all the conditions and provisions of the statute. The very power vested in Congress "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries" necessarily includes power to prescribe any and all conditions which Congress may in its wisdom consider calculated to aid in accomplishing this object. And if Congress considered dealings between inventors and the public before application for a patent, calculated "to promote the progress of science and useful arts"—by enabling inventors to perfect, introduce or manufactere their inventions—there can be no doubt of its power, by prescribing conditions, or otherwise, to require patents to be issued accordingly.

Other lines of reasoning and authorities could be suggested—such, for instance, as the provisions for the protection of innocent purchasers invariably connected with the extension of patents—but the above is considered ample to show the unsoundness of the attack made upon the constitutionality of Sec. 7 of the Act of 1839. It may be suggested, however, that notwithstanding such section has been in force more than half a century, being frequently re-enacted, and has often been the subject of judicial consideration, this is the first time, so far as our knowledge goes, that any attack has ever been made upon its constitutionality.

Implied License.

The fifth plea represents a defense very similar to the fourth; but proceeds on the theory that, without special regard to the statute, the circumstances show an implied agreement to the effect that, in consideration of assistance and privileges accorded in the development of his invention, Mr. Dable agreed that defendants should have a right to

use the "specific machines" constructed by him while in their employ. The case falls squarely within the rule of

McClurg v. *Kingsland*, 1 How., 202.
Chabot v. *Am. B. H. & O. Co.*, 6 Fish., 71, 73.
Magoun v. *Glass Co.*, 3 Banning & Arden, 114.
Barry v. *Crane*, 22 Fed. Rep., 396.
Wilkins v. *Spafford*, 3 Banning & Arden, 274.
Wind Mill Co. v. *Wind Mill Co.*, 4 Fish., 428, 432.
Brickill v. *Mayor*, 5 Banning & Arden, 544, 545–7.
Whiting v. *Graves*, 3 Banning & Arden, 222–4.
Wade v. *Metcalf*, 16 Fed. Rep., 130–1.
Slemmer's Appeal, 58 Penn. St., 155, 167.

Statute of Limitations.

If the Court should hold that, under the stipulation of counsel, the defenses presented by the fourth and fifth pleas are insufficient, then it will be proper to consider the defense considered by the second plea—whether plaintiff's claim is not barred by the Illinois Statute of Limitations.* This statute (Ch. 83, Sec. 15) is as follows:

> "Actions on unwritten contracts, expressed or implied, or on awards of arbitration, or to recover damages for an injury done to property, real or personal, or to recover the possession of personal property or damages for the detention or conversion thereof, and all civil actions not otherwise provided for, shall be commenced within five years next after the cause of action accrued."

Specifically stated, the question is, whether under the provisions of Sec. 34 of the Judiciary Act of 1789 (Sec. 721,

---

*If the judgment of the Circuit Court should be reversed and the cause remanded, which we do not expect, it will of course be necessary in future proceedings to know exactly how far back plaintiff should be allowed to recover damages; and hence, in this contingency, a decision of this question, as well as of the one presented by the third plea, to be presently considered, is earnestly requested.

Rev. Stat.), the State statute of limitations is applicable in an action at law to recover damages for infringement of a patent. This section provides that—

> "The laws of the several states, except where the constitution, treaties or statutes of the United States shall otherwise require or provide, shall be regarded as rules of decision in trials at common law in the Courts of the United States, in cases where they apply."

This is a "trial at common law," and therefore falls within Sec. 34, above quoted. The case does not come within the exception suggested by the words "except where the constitution, treaties or statutes of the United States otherwise require or provide;" hence "the laws of the several states"—in this case the laws of Illinois—are applicable, and should "be regarded as rules of decision." "The laws of the several states *shall be* regarded as rules of decision;" from which it may be said that the section is mandatory. It does not merely provide that the State laws *may be* regarded as rules of decision; but it goes farther, and is very explicit that they *shall be* so regarded.

It has been held, in at least seven cases, that under the provisions of Sec. 34, above quoted, State statutes of limitation are applicable in patent cases, to wit:

Parker v. *Hawk*, 2 Fisher, 58.
Parker v. *Hall*, 2 Fisher, 62.
Hayden v. *Oriental Mills*, 15 Fed. Rep., 605.
Sayles v. *R. R.*, 4 Banning & Arden, 239.
Sayles v. *R. R.*, 6 Sawyer, 31.
Rich v. *Ricketts*, 7 Blatch., 230.
Royer v. *Coupe*, 29 Fed. Rep., 358, 362.

And in *Hayward* v. *St. Louis*, 11 Fed. Rep., 427, Judge Treat intimates that they are applicable.

In *Hayden* v. *Oriental Mills*, 15 Fed. Rep., 605, Judges Lowell and Colt, while admitting that the weight of author-

ity in the Circuit Courts was against the applicability of a State statute, refused to be bound thereby, saying :

> "This result appears to us to be inadmissible. No reason is given for excepting one class of cases out of section 721. . . . There is no such exception in the statute itself, and none in its intent and purpose. To us it seems as admissible to say that section 721 does not apply to patent cases, as that the law adopting the general practice of the States does not apply to them. A dozen questions may arise in any patent case which can only be decided by the law of the State. When they thus repealed the Act of Congress, the State law became again applicable to future infringements."

In *Sayles* v. *The Railroad*, 4 Banning & Arden, 240, Judge Hughes said :

> "In providing that the laws of the several States shall be rules of decision in trials at common law in courts of the United States, except where treaties or Acts of Congress otherwise provide, Congress virtually adopted the statutes of limitation of each State as limitation of action brought in the United States Courts in that State. This point is so thoroughly settled that it is useless for me to cite authorities on the subject."

The other decisions cited proceed upon the same principle, that in no way have patent cases been excepted from the provisions of the above section.

This Court has four times decided that State statutes are applicable in patent cases. See

Vance v. *Campbell*, 1 Black, 427, 430.

Haussknecht v. *Claypool*, 1 Black, 431, 435.

Wright v. *Bales*, 2 Black, 535, 538.

Railroad Co. v. *Turrill*, 101 U. S., 836.

In *Vance* v. *Campbell*, Justice Nelson, speaking for the Court, after reciting the gist of the section in question, said:

> "This section has been construed to include the rules of evidence prescribed by the laws of the States in all civil cases at common law not within the exceptions therein mentioned."

The decision of the lower Court was reversed because of the exclusion of the testimony of a witness competent under the Ohio statutes, but incompetent by the rules of the common law. The decisions in *Hausknecht* v. *Claypool* and *Wright* v. *Bales* were to the same effect.

In *Railroad Co.* v *Turrill*, the Court held that interest should be allowed on a decree in a patent case at the rate provided by the State statute for interest on ordinary judgments. This decision is founded on the provisions of Rule 23 of the Supreme Court, that a judgment in the Federal Courts, affirmed in the Supreme Court, shall bear interest "at the same rate that similar judgments bear interest in the courts of the State where such judgment is rendered."

All these were patent cases, and yet the Court did not consider this material as distinguishing them from other cases, so far as regarded the applicability of State statutes relating to interest or the taking of testimony. In fact, they are based mainly on the rule of *McNiel* v. *Holbrook*, 12 Peters, 84, 88, which was a suit on promissory notes, and from which *Wright* v. *Bales* contains an extended quotation —thus showing that, in some respects at least, the Court did not consider that, so far as regarded the applicability of State statutes, there was any material difference between a patent case and other cases.

State statutes relating to jurisdiction over foreign corporations have also been held applicable to patent cases. See *U. S.* v. *Telephone Co.*, 29 Fed. Rep., 17; *Store Service Company* v. *Store Service Company*, 51 Off. Gaz., 969.

It is also well settled that State statutes of limitation are applicable to ordinary actions in the Federal Courts. (See *McCluny* v. *Silliman*, 3 Pet., 270; *Ross* v. *Duval*, 13 Pet., 45; *Leffingwell* v. *Warren*, 2 Black, 599; *Hanger* v. *Abbott*, 6 Wall., 532.) And if patent cases are to be treated the same as ordinary cases, so far as regards testimony, interest or juris-

diction, why should they be treated otherwise as to limitation of actions? If treated otherwise, this absurdity results—that section 34 may be applied to patent cases for some purposes and not for others. To us it seems that it must be applied for all purposes or none; one State law cannot be said to apply and another not; and if one State law is made applicable to patent cases by said section, all must be that are not in contravention of the constitution, laws or treaties of the United States. As Judges Lowell and Colt well say: "No reason is given for excepting one class of cases out of section 721. . . . There is no such exception in the statute itself, and none in its intent and purpose."

Looking at the reason of the rule, there can be no possible grounds for excepting patent cases from the operation of the statute. They are not more sacred than other cases, and no statute provides that a longer time shall be allowed for their prosecution. In fact, the legislative intent is clear that a longer time shall not be allowed. Why did Congress in 1874 repeal the special statute of limitation applicable to patent cases (Sec. 55, Act of 1870), and thus leave such cases in a position "where the constitution, treaties or statutes of the United States" do not "require or provide" anything on the subject, if it was not for the purpose of placing them in the same position as other cases, so that, under the Judiciary Act, "the laws of the several States should be regarded as rules of decision?"

The ground of the decision holding that State statutes of limitation are not applicable in patent cases, cannot be better stated than in the opinion of Judge McDonald in *Read* v. *Miller*, 2 Biss., 12; 3 Fisher, 310, 313. In this case Judge McDonald said:

> "The constitution of the United States has given to the National Government exclusive control of the whole subject-matter of patent rights for new and useful inventions. No State, therefore, can pass any valid law

> concerning them. . . . Since, then, no State has any power to legislate concerning patent rights, and no State court has jurisdiction to adjudicate concerning any violation of them, it can hardly be supposed that a State may, nevertheless, pass statutes of limitation concerning them, which shall control National Courts in suits brought for their infringement."

That this reasoning is erroneous is clear from this Court's decisions, above referred to, holding that State statutes relating to evidence and interest are applicable in patent cases. Judge McDonald says that "no State has any power to legislate concerning patent rights" to an extent that "shall control the National Courts in suits brought for their infringement;" this Court says, four times, that *Congress has power to adopt State legislation* to an extent that shall control the National Courts in suits brought for infringement of patents, so far as regards question of interest and evidence.

Judge McDonald also says:

> "Section 34 of the Judiciary Act only makes the laws of the several States rules of decision in the National Courts '*in cases where they apply.*' Now, it appears to me that these State laws do not apply in cases over which State governments have no control whatever, and which are under the exclusive control of the general government."

Our answer to this is, that this Court has four times held that State laws *do* apply to patent cases which are "cases over which the State governments have no control whatever," etc. If Judge McDonald's reasoning is sound, then this Court was clearly wrong every time it held State statutes relating to evidence and interest applicable in patent cases.

Again, Judge McDonald says "that, should a State legislature pass an act in express terms, limiting the action on the case for violating patent rights, . . such an act would be unconstitutional and void." This may be true, but it does not affect the question whether, under the Judiciary Act,

Congress may not adopt State statutes of limitation for patent cases, as well as for other cases. And right here lies the error of *Read* v. *Miller*, and similar cases; they proceed on the theory that a State has no power to pass an act affecting patents, and fail to recognize that *the case is simply one where, under the Judiciary Act, Congress has adopted a State statute.* They overlook the fact that the State has not attempted to control the Federal Courts, has had no such idea, that it has merely passed laws for its own government, which it has an undoubted right to do, and that *these laws have been practically re-enacted by Congress in its adoption of them by the Judiciary Act.* Of course Congress has power to pass a statute of limitations for patent cases; and why may it not do this by adopting laws already passed by the States?

Suit by Assignee.

The question presented by the defendants' third plea is, whether the plaintiff can maintain an action at law in its own name for damages arising out of infringements committed before it acquired title?

The declaration alleges that the Dable patents were assigned to plaintiff December 8, 1880, along with "all rights of action whatever accrued thereunder before the date of said assignment in said inventions." (3.) The defendants' contention is that, even if this be true, it does not authorize plaintiff to sue at law, in its own name, for damages accruing from infringements committed before the assignment; the suit should be in the name of Dable for the use of plaintiff.

Under the common law it is well settled that the assignor must have some substantial possession, and some capability of present enjoyment, and not a mere naked right to overset a legal instrument, or commence a suit. 2 Story Eq., Sec. 1040 g.; *Norton* v. *Tuttle*, 60 Ills., 130. "No

case can be found which decides that such a [mere naked] right can be the subject of assignment, either at law or equity." *Posser* v. *Edmonds*, 1 Younge & C., 481; *Woods* v. *Downs*, 18 Ves., 120; *Corbin* v. *Emerson*, 10 Leigh, 663.

But, even admitting that such assignment could be good at common law, it would still be insufficient to transfer the legal title to infringement claims, so as to enable the assignee to sue therefor in his own name.

The 11th section of the Act of 1836 declares what may be assigned, and the 14th section, what persons may maintain a suit. Suits are "to be brought in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout specified part of the United States." And the same language is used substantially in Sec. 59 of the Act of 1870, and Sec. 4919 of the Rev. Stat. of 1874.

The right to assign a patent and the right to maintain a suit for its infringement both exist solely by virtue of these enactments, and cannot be extended beyond them. But there is nothing in any of these enactments about assigning the right to sue for past damages or profits, and especially nothing to authorize a suit in his own name by an assignee. There is nothing, therefore, in any of the Acts of Congress to lend any support to such actions.

In *Blanchard* v. *Eldridge*, 1 Wall. Jr., 340, it was held that the word "assignees" in the 14th section must

> "be construed by reference to the 11th section already referred to, which defines in what way a patent may be assigned—to wit: either the whole or any undivided portion of the whole."

In *Moore* v. *Marsh*, 7 Wall., 520, the Court, construing this section, say:

> "Assignees and grantees, as well as the patentee, may, under some circumstances, maintain an action on the case for an infringement in their own name, as ap-

pears by express words of the act of Congress. An assignee is one who holds, by a valid assignment in writing, the whole interest of a patent, or any undivided part of such whole interest throughout the United States."

In *Agawam Co.* v. *Jordan*, 7 Wall., 593, it is said that—

"The suit must be brought in the name or names of the person or persons interested, whether patentees, assignees, or as grantees, as aforesaid, of the exclusive right within a specified locality."

In *Gordon* v. *Anthony*, 4 Banning & Arden, 261, Judge Blatchford said:

"Under sections 11, 14 and 17 of the Act of July 4, 1836, 5 U. S. Stat. at Large, 121, 123, 124, it was always held that no one could bring a suit, either at law or in equity, for the infringement of a patent in his own name alone, unless he were the patentee, or such an assignee or grantee as is mentioned in the 11th and 14th sections of that Act. . . .

"These provisions were considered by this Court in the case of *Nelson* v. *McMann*, 16 Blatchf., C. C. R., 139. Under them no person can bring a suit for profits or damages for infringement, who is not the patentee or such an assignee or grantee as the statute points out. A claim to recover profits or damages for past infringement cannot be severed from the title by assignment or grant, so as to give a right of action for such claim, in disregard of the statute. The profits or damages for infringement cannot be sued for except on the basis of title as patentee, or as such assignee or grantee, to the whole or a part of the patent, and not on the basis merely of the assignment of a right to a claim for profits and damages, severed from such title."

As to the time preceding the assignment to plaintiff, the patent sued on may be considered as having expired, and as to such time the only possible right existing and capable of being assigned to plaintiff was the right to collect damages for past infringement. A mere assignee of infringement claims cannot possibly be considered as owner of the patent, either for the whole United States or within a specified lo-

cality, and, therefore, he cannot be an assignee within the meaning of the law as above construed. He cannot sue on the basis of title as assignee, but his suit must be on the "basis merely of the assignment of a right to a claim for profits and damages, severed from such title."

As already suggested, there is nothing in the statute about assigning the right to sue for past damages or profits; nothing to authorize a suit for such damages or profits by an assignee. The suit must therefore be, in accordance with the rule of the common law, in the name of the patentee for the use of his assignee, if it can be maintained at all; and as to all claims for infringement prior to the assignment to plaintiff, December 8, 1880, we submit that it should be so prosecuted.

In view of all the foregoing, we respectfully submit (1) that complete defenses are presented by the fourth and fifth pleas and stipulation of counsel, and hence that the judgment of the Circuit Court should be affirmed; (2) that if this be not so, the Illinois Statute of Limitations is applicable; and (3) that, in any view, plaintiff should not be allowed in this suit to recover damages accruing from infringements committed before the date of the assignment under which it holds title.

EPHRAIM BANNING,
THOMAS A. BANNING,
Counsel for Defendants in Error.